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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/873,974	06/12/1997	MICHAEL C. SCROGGIE	CATALINA	2461

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NEIFELD IP LAW, PC
CRYSTAL PLAZA 1, SUITE 1001
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ARLINGTON, VA 22202

EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 09/23/2002

~~42~~ 45

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/873,974

Applicant(s)

SCROGGIE ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

In response to the communication received on 7/10/01, the following is a non-final office action. Claims 50-89 are pending in this application and have been examined on the merits. Claims 50-89 are rejected. Claim 63-66, 73-76, and 83-86 have been rejected as containing new subject matter which can be overcome by timely filing a CIP of parent application 08/622685, as agreed in the personal interview given 1/20/00.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 63-66, 73-76 and 83-86 and all claims which depend from them are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 63-66, 73-76 and 83-86 and all claims that depend for them will therefore not be examined. The following is constituted as new matter: Page 3, lines 13-15, claim 63 of the amendment filed 2/16/00 which recites a process which includes the steps of "transmitting from said cooperative network site said

geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site". Page 3, lines 17-24, claim 64 of the amendment filed 2/16/00 which recites a process which includes the steps of "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site; transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site".

Page 4, lines 2-9, claim 65 of the amendment filed 2/16/00 which recites a process which includes the steps of "transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to aid consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site; transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". Page 4, lines 11-19, claim 66 of the amendment filed 2/16/00 which recites a process which includes the steps of "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer including incentive data for manufacturer offers available at

said retailer to aid consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site; transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". Page 6, lines 8-10, claim 73 of the amendment which recites "means for transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site". Page 6, lines 12-19, claim 74 of the amendment which recites "means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site; means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". Page 6, line 21-Col. 7, line 4, claim 75 of the amendment filed 2/16/00 which recites "means for transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to aid consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site; means for transmitting by said consumer

incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". Page 7, lines 6-14, claim 76 of the amendment filed 2/16/00 which recites "means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer including incentive data for manufacturer offers available at said retailer to aid consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site; means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". Page 9, lines 9-11, claim 83 of the amendment filed 2/16/00 which recites a computer program product which performs the steps of "transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site". Page 9, lines 14-21, claim 84 of the amendment filed 2/16/00 which recites a computer program product which performs the steps of "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site; transmitting by said consumer incentive selection data selected from said incentive data to said

cooperative network site via said retailer network site; and transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". Page 10, lines 1-8, claim 85 of the amendment filed 2/16/00 which recites a computer program product which performs the steps of "transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to aid consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site; transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". Page 10, lines 11-19, claim 86 of the amendment filed 2/16/00 which recites a computer program product which performs the steps of "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer including incentive data for manufacturer offers available at said retailer to aid consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site; transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". These limitations were not properly described in the application as filed. Since the applicant failed to amend

the specification to make the present application a CIP of parent application 08/622685, as agreed in the interview given 1/20/00, all claims which present additional matter are constituted as new subject matter because these new claim limitations were not satisfactorily resolved by the examiner and consequently raise doubt as to possession of the claimed invention at the time of filing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 50, 51, 54, 60, 61, 70, 71, 80, 81, are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claims 50, 60, 70, 80, Sloane discloses:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer.../storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer.../means for storing...(Col. 7, lines 22-26);

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network...(Col. 7, lines 13-17, where the retailer computer/controller of Sloane is analogous to the cooperative network site and the sender of Sloane is analogous to the manufacturer);

a consumer computer coupled to one of said manufacturer network site...(Fig.'s 4 and 5 where the consumer computer is represented as the portable bar code scanning device of Sloane);

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request...(Col. 7, line 65-Col. 8, line 7, Col. 8, lines 44-48).

As per claims 51, 61, 71, 81, the following is inherent with Sloane because Sloane teaches that the manufacturer/retailer incentives are stored by the retailer computer/controller in Col. 7, lines 22-26. In addition, Sloane discloses that the computer/controller contains a database which stores information in Col. 8, lines 50-54:

wherein said cooperative network site is configured to store at least one of said manufacturer incentives and retailer incentives in a database.../storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a database coupled thereto.../means for storing...

As per claim 54, Sloane discloses:

Wherein, in response to a query from said consumer made over said communication network from said retailer network site, said cooperative network site transmits incentive data for manufacturer offers available at said retailer to said consumer...(Col. 8, lines 3-7, where the query is analogous to the product scan information made by the consumer);

Said consumer transmits incentive selection data selected from said incentive data...(Col. 8, lines 41-45);

Said cooperative network site transmits incentives corresponding to said selection data to said consumer...(Col. 8, lines 46-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 52-53, 55-59, 62, 72, and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Narasimhan, et al (US Patent 6,237,145 B1).

As per claim 52, 62, 72, 82, Sloane discloses:

Said consumer transmits incentive selection data selected from said incentive data to said cooperative network.../transmitting by said consumer incentive selection data.../means for transmitting...(Col. 8, lines 34-37);

Said cooperative network site transmits incentives corresponding to said selection data to said consumer.../transmitting from said cooperative network site incentives corresponding to said selection data .../means for transmitting...(Col. 8, lines 37-39).

Sloane fails to disclose the following, however Narasimhan, et al discloses:

Wherein, in response to a query from said consumer made over said communication network from said manufacturer network site, said cooperative network site transmits a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer.../transmitting from said cooperative network site a geographically limited list of retailers.../means for transmitting...(Col. 4, lines 62-65, Col. 8, lines 4-13);

It would have been obvious to one of ordinary skill in the art for a geographically limited list of retailers honoring incentives and corresponding incentive data to a consumer with the motivation of giving the consumer the ability to customize and control his or her purchase preferences by location.

As per claim 53, neither Sloane or Narasimhan, et al disclose:

Wherein said cooperative network site transmits said geographically limited list of retailers based on a postal code...

Official notice is taken that it is old and well known in the art to have a geographical list sorted by postal code. It would have been obvious to one of ordinary skill in the art to sort a geographical list by postal code in order to specifically define the closest locations in which incentive data can be sent.

As per claim 55, Sloane discloses:

Said consumer transmits incentive selection data...(Col. 8, lines 34-37);

Said cooperative network site transmits incentives corresponding to said selection data...(Col. 8, lines 37-39).

Sloane fails to teach the following, however Narasimhan et al discloses:

Wherein, in response to a query from said consumer made over said communication network from said retailer network site, said cooperative network site transmits a consumer personal page...(Col. 4, lines 41-45).

It would have been obvious to one of ordinary skill in the art to transmit a consumer personal page with the motivation of offering the consumer with a page specifically customized for his or her purchasing purposes.

As per claim 56, Sloane discloses:

Said consumer transmits incentive selection data...(Col. 8, lines 34-37);

Said cooperative network site transmits incentives corresponding to said selection data...(Col. 8, lines 37-39).

Sloane fails to teach the following, however Narasimhan et al discloses:

Wherein, in response to said consumer transmitting an identification code over said communication network from said retailer network site, said cooperative network site transmits incentive data for manufacturer offers available....(Col. 6, lines 50-59).

It would have been obvious to one of ordinary skill in the art to transmit an identification code over the communication network with the motivation of transmitting the incentive to a specific identified consumer.

As per claim 57, Sloane discloses:

Wherein said incentive data is based on said consumer specific data comprising a shopping history of said consumer...(Col. 8, lines 50-63).

As per claim 58, Sloane fails to disclose, however Narasimhan et al discloses:

Wherein said incentive data is based on said consumer specific data comprising demographic data...(Col. 9, lines 5-16).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to base incentive data on demographic data with the motivation of

offering incentives to customers based on the size, density and distribution of a population of consumers.

As per claim 59, Sloane fails to disclose, however Narasimhan et al discloses:

Wherein said incentive data is based on said consumer specific data comprising customer profile data...(Col. 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art for incentive data to be based on customer profile data with the motivation of offering customers incentives with relation to specific customer qualities.

Response to Arguments

Applicant's arguments with respect to claims 50-89 have been considered but are moot in view of the new ground(s) of rejection as discussed above in the preceding paragraphs.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30 am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238

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[After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A.R.B.

A. R. B.

September 16, 2002

TARIQ R. HAFIZ
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